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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
33692.03.3198

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on February 25, 2009

Signature /Christine A. Wright/

Typed or printed name Christine A. Wright

Application Number	Filed
10/685,919	October 15, 2003

First Named Inventor
William E. Welnick

Art Unit	Examiner
2617	Sharad K. Rampuria

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number 34,414 .

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

/Christopher J. Reckamp/
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Typed or printed name
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Telephone number
February 25, 2009
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Welnick, William E., et al.   Examiner: Rampuria, Sharad K.
Serial No.: 10/685,919   Art Group: 2617
Filing Date: October 15, 2003   Docket No.: 33692.03.3198
Confirmation No.: 7060
Title: **CIRCUIT AND METHOD FOR ACQUIRING A MORE-PREFERRED SYSTEM IDENTIFIER (SID) ELEMENT**

<u>**REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**</u>

Dear Sir:

The Examiner has made clear errors since claim language has been ignored and since the references do not teach what is alleged.

Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,734,980 (issued Mar. 31, 1998) to Hooper, et al., of record, [hereinafter *"Hooper"*], in view of U.S. Patent No. 5,442,806 (issued August 15, 1995) to Barber, et al., [hereinafter *"Barber"*]. <u>See</u> <u>OA</u>, page 2.

Claim 6, 8, 10, 14 and 19 are all rejected in one sentence that reads "[these claims] are the wireless device, memory containing instructions executable by one or more processing devices, method claims, corresponding to the logic circuitry claim 1 respectively, and rejected under the same rationale set forth in connection with the rejection of claim 1 respectively, above." (final action, page 6). Applicants respectfully submit that this is clear error since these claims include additional limitations not set forth in claim 1. Accordingly, these claims have not been properly rejected and the Applicants have not been put on proper notice of the basis for the rejection of the claimed subject matter. By way of example, claim 8 requires logic circuitry that also performs other operations such as attempting the acquisition based on a comparison of the received broadcast SID information with one of a plurality of stored SID elements and wherein

the second more-preferred SID acquisition sequence is again performed if acquisition of the plurality of stored SID elements in the roaming list is unavailable. This language has not been addressed as to claim 8 and Applicants respectfully submit that there has been clear error. In addition, claim 8 requires that a single acquisition attempt is made of each of a plurality of less-preferred stored SID elements not acquired during the first more-preferred SID acquisition sequence as part of the second more-preferred SID acquisition that also included a repeated more-preferred SID acquisition sequence using the same frequency. This language has not been addressed as to claim 8 and Applicants respectfully submit that there has been clear error.

There is also clear error since the references do not teach what is alleged. As to claim 1, the office action admits that the Hooper reference fails to teach, among other things, the operation of the claimed logic circuitry. The office action cites Barber as allegedly teaching

"logic circuitry, operatively coupled to the memory, and operative to perform a first more-preferred SID acquisition sequence and then a second more-preferred SID acquisition sequence that includes repeatedly attempting acquisition of the at least one more-preferred stored SID element using a same frequency during the second more-preferred SID acquisition sequence." (e.g., col. 4; 66-col. 5; 27) (Final action, page 3).

However, Barber does not teach what is alleged. Barber is directed to a different system that employs primary and secondary frequency sets. The secondary frequency set is not a more-preferred scan list but to the contrary is merely a second frequency set that is not scanned as part of a SID acquisition sequence. Barber only describes what is commonly known in the industry as primary and secondary A/B channels which are located in the number assignment module (NAM). The cited portion does not describe any kind of repeated scanning of a more-preferred SID using a same frequency during the second scan. It simply describes how frequencies are used in scanning and are organized and why they are organized in that way.

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In contrast, the claim requires that the logic circuitry performs repeated scanning via repeatedly attempting acquisition of at least one more-preferred stored SID element using a same frequency during the second more-preferred SID acquisition sequence. As such, there is a first more-preferred SID acquisition sequence and then a second more-preferred SID acquisition sequence wherein operation repeatedly attempts acquisition of the more-preferred stored SID element during the second more-preferred SID acquisition sequence using the same frequency. If the above reference taught what is alleged, Barber would have to teach that the "secondary (or non-home)" frequency set is a more-preferred scan list and that it was repeatedly scanned as part of a more-preferred (not less) SID acquisition sequence. However, as known in the art and is obvious to one of ordinary skill in the art, the secondary or non-home frequency set is not included in any more-preferred SID acquisition sequence.

Moreover, in the "Response to Amendments and Remarks" section of the office action, the office action merely states a conclusion that is not supportive of teaching of the claimed subject matter. The cited portion refers to a cellular telephone that can be located within the overlapping portion between a primary carrier cell coverage area and the secondary carrier cell coverage area. The primary and secondary lists are not used as a more-preferred SID acquisition sequence scanning operation. There is no discussion whatsoever in the cited portion set forth on page 7 of the final action that discusses repeatedly attempting acquisition of the more-preferred SID element using a same frequency during a second more-preferred SID acquisition sequence. Accordingly, Applicants respectfully submit that there has been clear error since the Barber reference does not teach what is alleged.

In addition, the "Response to Amendments and Remarks" section of the final action also refers to the Hooper reference citing column 9, lines 45 to column 10, line 10. However, again

as clearly stated by Hooper, the description actually refers to "lesser preferred" systems on a list and also does not describe repeatedly attempting acquisition of at least one more-preferred stored SID element using a same frequency during a second more-preferred SID acquisition sequence. In other words, the cited reference does not teach repeatedly scanning the same frequency of a more-preferred stored SID element. Instead, Hooper teaches going to a next lesser preferred and different frequency.

Neither the Barber reference nor the Hooper reference teach what is alleged. Neither reference teaches repeatedly scanning a more-preferred stored SID element using a same frequency during a second more-preferred SID acquisition sequence as claimed. Among other advantages, the claimed operation improves the acquisition of the search for a more-preferred stored SID element stored in the roaming list. Conventional scanning sequences, such as those of Barber or Hooper scan for the home system only once within the more-preferred SID sequence. As claimed however, the more-preferred SID acquisition sequence is scanned more often than a conventional roaming operation. By extending the search for the more-preferred system repeatedly as part of the more-preferred SID acquisition operation, the window of opportunity to find a more-preferred system will be increased, increasing the likelihood that the wireless device will acquire the more-preferred system. (See for example, Applicants' Specification, paragraph 50).

Since claim language has been ignored and/or since the references do not teach what is alleged, there has been clear error in rejection of the claims and the rejections must be withdrawn.

Reconsideration and withdrawal of the rejection of the claims is respectfully requested.

A Notice of Allowance is also respectfully requested.

Respectfully submitted,

Date: February 25, 2009

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